

Appln No. 09/693,134
Amdt. Dated June 29, 2004
Response to Office action of June 3, 2004

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REMARKS/ARGUMENTS

The Applicant thanks the Examiner for the Office Action dated June 3, 2004.

INFORMATION DISCLOSURE STATEMENT

The documents referred to on page 12 of the specification describe well-known Reed Solomon encoding. These documents are referred to in the specification for background information only. The Applicant does not consider these documents to be relevant to examination of the present application and has, therefore, not included these documents in an information disclosure statement.

CLAIM REJECTIONS - 35 USC § 103

The Applicant maintains that the present invention is not obvious in view of Kuchta et al (US 5,164,831), and further in view of Soscia (US 5,996,893) and Nelson et al (US 6,191,406).

At the heart of the Examiner's argument is the assertion that the skilled person would find it obvious to store invisible *image* data over a photograph, given the disclosure of Soscia. It is this assertion which the Applicant vigorously contests.

The Examiner has directed the Applicant to column 7, lines 26-30 of Soscia, where it is stated:

Furthermore, the methods and apparatus of the present invention can be used for locating, identifying and printing different types of information and not merely audio information on a photograph in a manner that is invisible to the naked eye.

This passage of Soscia does not, in the Applicant's submission, constitute a teaching to print invisible image data onto a photograph, where these image data correspond to the photograph.

Soscia merely provides a suggestion to the skilled person that other types of information may be printed over the photograph. Without the benefit of hindsight, one can only assume

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that Soscia was referring to the types of information usually presented with photographs. The types of information usually presented with photographs are, for example, the time, date and place at which the photograph was taken. Indeed, it was common in the art at the time to visibly print such information onto photographs and it would be a natural extension of the method described in Soscia to print this type of information in an invisible form. The skilled person would not require a scintilla of inventiveness to extend the methodology of Soscia in this way.

However, the Applicant submits that it would not be a natural extension of the method described in Soscia to print fault tolerant encoded image data onto a photograph, where that image data corresponds to the photograph. At that time, the idea of invisibly printing corresponding image data onto a photograph had not been conceived so it is difficult to see why the skilled person would want to start printing this type of information onto photographs, given that the only types of information being conveyed with photographs at that time was information relating to time, date, place *etc.*. Soscia certainly does make the intellectual leap required to realize that conveying corresponding image data in photographs would be useful for electronically transmitting digital images of photographs. Soscia does not even mention electronic transmission of digital images.

It is further submitted that the question of obviousness is not determined by whether the skilled person *could* have done something, but whether the skilled person *would* have done so, given the relevant teaching of the prior art. Whilst the skilled person *could* have printed invisible image data onto photographs, given the teaching of Soscia, the Applicant submits that he would not have done so, because there appeared to be no reason at that time to print such information onto photographs. As the Applicant has already argued, it is entirely counterintuitive to print invisible image data onto a photograph, where the image data corresponds to that photograph. The prior art at that time was wholly concerned with conveying *further* information on photographs (*e.g.* audio data or time/date/place information), not conveying corresponding image data in an invisible fault tolerant form to facilitate electronic transmission.

As regards Kuchta, the Applicant does not consider this document to be relevant to the central issue of obviousness. As the Examiner admits, Kuchta makes no mention of invisibly printing image data over photographs.

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The central issue in this case is that it is not obvious to print a photograph and simultaneously print corresponding invisible image data relating to that photograph. Once the Examiner concurs with the Applicant on this issue, she will agree that the disclosure of Kuchta is no longer relevant. Likewise, the disclosure of Nelson is not considered to be of any further relevance to the central issue of obviousness.

In view of these submissions, the Examiner is kindly requested to withdraw her objection of obviousness against claim 1 of the present application. Since the remaining claims are dependent on claim 1, it is submitted that the objections of obviousness against these claims should, likewise, be withdrawn.

DOUBLE PATENTING

For the sake of avoiding repetition, the Examiner is respectfully requested to take note of the Applicant's submissions above in her examination of obvious-type double patenting in respect of Kuchta. Once the objection of obviousness is withdrawn, it is submitted that the objection of double patenting in respect of Kuchta should, likewise, be withdrawn.

It is respectfully submitted that all of the Examiner's objections have been successfully traversed. Accordingly, it is submitted that the application is now in condition for allowance. Reconsideration and allowance of the application is courteously solicited.

Very respectfully,

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